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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL6115P0011US	2171
4743	7590	09/14/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			RETTA, YEHDEGA	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/871,867	MALNEKOFF, PETER J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yehdiga Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 and 20-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

This office action is in response to amendment filed June 16, 2005. Applicant amended claims 1, 8, 15-18 and canceled claim 19. New claims 20-22 have been added. Claims 1-18 are 20-22 are currently pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18, 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites, “an input device adapted to receive a gemstone laboratory grading certificate via a remote communication device”. Applicant specification teaches gemstone data received from a user, being typed by a user. The specification does not teach the input device receiving the data via a remote communication device. Therefore the newly added feature is considered new matter. Applicant’s specification also does not teach the input device receiving gemstone laboratory grading certificate. The specification teaches the input device receiving data contained on the various lab certificates associated with gemstone or which provides specific information about each gemstone. The specification does not teach receiving a certificate, thus this added feature is also a new matter.

Dependent claims are rejected since they depend on rejected claim.

Regarding claim 20, applicant's specification does not disclose allowing user to modify a value of any of the physical characteristics of the gemstone and adjusting the fair market pricing estimate based on the modified value. This added feature is considered new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Aggarwal (6,236,867).

Regarding claim 1, Aggarwal teaches an input device adapted to receive a gemstone laboratory grading certificate via a remote communication device, the gemstone laboratory grading certificate including cut type, weight, color, etc., (see col. 1 lines 62 to col. 2 line 60 and col. 14 line 16 to col. 16 line 27). Aggarwal (page 3, provisional application) teaches insurers and consumers are interested in reclaiming lost or stolen goods recovered by police or retailers. In addition to the aforementioned security concerns, presently, gem stones must be shipped or sent by a courier for appraisal or for evaluation by an interested buyer. An electronic means of transferring

text, numerical and visual data that accurately presents the various attributes of a gem stone can significantly improve transaction while reducing associated costs. Aggarwal also teaches each stone having a unique folder assigned to it in which the images captured by DIG are placed along with a text file that contains information on ownership, results of analysis and appraisal report and other pertinent information, and in one preferred embodiment the analysis is done locally; whereas, in other preferred embodiment, the folder or a set of folders is sent to a central database services where the folder and its content are backed up for data security. Thereafter, contents of the folder are analyzed to prepare an appraisal report (see page 13 line 28 to page 14 line 3). Therefore Aggarwal teaches evaluating a gemstone without the present of the gemstone. Aggarwal teaches processing device adapted to compute a pricing estimate for use in an evaluation report based at least upon the data included on the gemstone laboratory grading certificate and an output adapted to communicate the evaluation report to the system user (see col. 5 lines 1-37 and col. 16 lines 28-39) (see also the provisional application pp 3 line 26 to page 4 line 7, pp 6 lines 25-30, pp 13 lines 24 to pp 14 line 3 and fig. 21).

Regarding claim 2, Aggarwal teaches report including qualities of the gemstone (see col. 15 line 1-18 and col. 16 lines 28-38).

Regarding claim 4, Aggarwal teaches allowing the gemstone data to be received from a remotely located device and allowing the report to be communicated to the remotely located device (see col. 5 line 38 to col. 7 line 47).

Regarding claims 5 and 6, Aggarwal teaches printer for printing the evaluation report and display screen (see fig. 1 and col. 6 lines 27-57).

Regarding claim 7, Aggarwal teaches system user, inputting data. Whether the user is a consumer or not does not change the claimed feature of entering data in the system of Aggarwal. Therefore, no patentable weight is given to the user being a consumer.

Claims 8, 15 and 16 are rejected as stated above in claim 1.

Claim 9 is rejected as stated above in claim 2.

Claim 11 is rejected as stated above in claim 4.

Claims 12, 13 and 18 are rejected as stated above in claims 5 and 6.

Claim 14 is rejected as stated above in claim 7.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal (6,236,867) in view of Vanier et al. U.S. Patent No. 5,828,405.

Regarding claims 3 and 10, Aggarwal does not teach price estimate including a separate price estimate for each of different types of retail outlets. Vanier teaches appraised value of jeweler being entered and stored in a database (see col. 6 lines 40-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide different price for different retail store, since different type of stores pay different price for gemstones and sell it for different price.

Regarding claim 17, Aggarwal teaches indexing data structure, based on cut style weight, color and clarity of the gemstone, reading indexed list price value (see col. 14 line 66 to col. 16 line 39). Aggarwal does not teach adjusting price value based on jeweler pricing adjustment. Vanier teaches jewelers entering appraised value of gemstone appraised valued being stored in a database, the value being high from which there is a substantial discount. It would have been obvious to one of ordinary skill in the art at the time of the invention to appraise the gemstone according to jeweler price, from which the gemstone was purchased or sold, since different retail stores pay different price for the gemstones.

Regarding claims 21 and 22, Aggarwal does not teach the processing device adapted to adjust the pricing estimate based on a laboratory identifier or retail outlet identifiers. Vanier teaches the pricing of gemstone for insurance purpose. Vanier teaches user key in information with respect to the owner and the characteristics of the gemstone. Vanier teaches insurance company using the database of appraised value and characteristics of the gemstone to reflect any increased value of the gemstones overtime, which provides valuable information to insurance company. Therefore it would have been obvious to one of ordinary sill in the art at the time of the invention to implement Vanier's appraisal method in Aggarwal's grading method for the intended use of providing valuable information to insurance company in order to proved insurance coverage for the gemstone. It also would have been obvious to include different price estimate for each type of retailers based on the jewelry market, which is also based on the grading quality, in order to insure the gemstone appropriately, based on the price paid by buyer.

Claims 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal (6,236,867) in view of “A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation” MIS Quarterly/March 1994, (hereinafter Zale).

Regarding claim 20, Aggarwal does not teach allowing user to modify a value of any of the physical characteristics of the gemstone and adjusting the fair market pricing estimate based on the modified value of the physical characteristics of the gemstone, it is taught in Zale. Zale teaches a gemologist modifying data elements that now differ from the original specification because of the current condition of an item (see page 24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the existing data of a gemstone, for the intended use of appraising the stone based on the current condition.

***Response to Arguments***

Applicant's arguments filed June 16, 2005 have been fully considered but they are not persuasive.

Applicant argues that the Aggarwal provisional application does not disclose a gemstone evaluation system than can be used to provide an evaluation report for a gemstone in the absence of the gemstone. Examiner disagrees. Aggarwal teaches data pertaining to a gemstone captured and the data transferred to a remote location and the appraisal being done at the remote location. Therefore, Aggarwal teaches the evaluation being done without the presence of the gemstone (see page 13 line 28 to page 14 line 4).

Applicant states that Aggarwal discloses a database and analytical software to produce an appraisal report, it does not disclose producing an evaluation report using cut

Art Unit: 3622

proportions of the gemstone as recited in claim 1. On page 12, the provisional application discloses imaging process performed on each gemstone including images used for cut analysis, and on page 9 discloses that a database and analytical software specifically designed for the gem grading system analyze these images and extract pertinent information from them to produce an appraisal report. Therefore, it is clear that the database includes the cut proportion and other gemstone characteristics used for evaluation.

Applicant also argues that since Vanier requires the presence of a stone being evaluated and does not use predetermined gemstone data, teaches away from the gemstones evaluation system of claim 1. Vanier was introduced to teach the adjusting price value based on jeweler pricing adjustment. It does not change the determining of the price estimate, whether it is done with or without the presence of the gemstone.

Examiner would like to point out that applicant's disclosure does not specifically indicate that the data entered to the input means is without the presence of the stone. Even if it did, there is no patentably difference between the prior art and applicant's claimed invention, since presence of the stone does not change the data entered and the evaluation done by the system. In other words the data entered and the evaluation performed is the same as the prior art. The prior art also teaches the measurements being taken with the presence of the stone and the evaluation being done locally or at a remote location, i.e., without the presence of the stone. As best understood by the examiner applicant's data used for the grading certificate is also extracted using the stone. Therefore, there is no patentable difference between the invention as claimed and the prior art.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER